

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of	:	Customer Number: 46320
	:	
Simon HOLDSWORTH	:	Confirmation Number: 6280
	:	
Application No.: 10/016,935	:	Group Art Unit: 2143
	:	
Filed: December 14, 2001	:	Examiner: J. Avellino
	:	
Appeal No. 2008-2482	:	
	:	
For: MANAGING A FAILURE TO ACCESS A DATABASE IN A COMPUTER SYSTEM		

REQUEST FOR REHEARING

Mail Stop Appeal Brief - Patents
Commissioner For Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Request for Rehearing is submitted under 37 C.F.R. § 41.52 in response to the Decision on Appeal dated March 17, 2009 (hereinafter the Decision). This Request for Rehearing is timely filed within the two month time period for reply set forth under 37 C.F.R. § 41.52(a)(1).

Appellant respectfully submits that in the Decision on Appeal, the Honorable Board either misapprehended and/or overlooked certain arguments presented by Appellant in the Appeal Brief of August 11, 2006, and in the Reply Briefs of October 10, 2006, and December 4, 2006 (hereinafter the First and Second Reply Briefs). Appellant will specifically identify these particular points below.

REMARKS

Decisions of the PTO tribunals are reviewed in accordance with the standards of the Administrative Procedure Act. See Dickinson v. Zurko, 527 U.S. 150, 165 (1999) (applying the Administrative Procedure Act, 5 U.S.C. § 706, to appeals of PTO rulings). Thus the Board's factual findings are reviewed to determine whether they are unsupported by substantial evidence, and the Board's legal conclusions are reviewed for correctness in law. See In re Gartside, 203 F.3d 1305, 1312 (Fed. Cir. 2000).

In the paragraph spanning pages 11 and 12 of the Decision, the Honorable Board presented the following conclusion as to the scope and content as to the applied prior art:

Under the broadest reasonable interpretation consistent with the Specification, we agree with the Examiner that Narasimhan's "selection of an alternate destination server and determination of the computer network routing information required for sending the filtered message to the alternate destination server can be construed as the claimed 'selecting a message filtering policy based on a communication characteristic'" (Ans. 14; *see also* FF 3-4). Appellant has not pointed to any particular definition of "communication characteristic" or "message filtering policy" in the Specification that would require a different interpretation.

At the outset, Appellant notes that the Honorable Board's analysis does not rest upon any explicit claim construction provided by the Examiner. Instead, referring

to page 11 of the Decision, the Honorable Board's analysis relies upon the following statement, which is found on page 4 of the Examiner's Answer:

Narasimhan discloses another message brokering system which discloses selecting a policy, based on the communication characteristic of the network (i.e., if server A is down, then go down the list of user defined available servers until an appropriate server is found which can route the message to the user) (col. 4, lines 30-63; col. 5, lines 25-30; col. 7, lines 1-15).

On page 12 of the Decision, the Honorable Board presented the following claim construction analysis:

The claimed "communication characteristic of an inter-broker communication link" is broad enough to encompass the characteristic of whether an inter-broker communication link is effective to communicate with a server. If the server is down, the link is not effective to communicate with that server.

Appellant respectfully disagrees with the Honorable Board's analysis. Also, since the Examiner failed to provide a claim construction as to the terms at issue, the Honorable Board's newly-presented claim construction represents a new ground of rejection. As such, designation as a new ground is necessary because Appellant has not had a fair opportunity to react to the thrust of the "affirmance" of the rejection, which is based upon a claim construction that was not shared with Appellant until after the Decision had been rendered by the Honorable Board. See In re Kumar, 418 F.3d 1361, 1367-68 (Fed. Cir. 2005) ("the ultimate criterion of whether a rejection is considered 'new' in a decision by the board is whether appellants have had fair opportunity to react to the thrust of the rejection") (quoting In re Kronig, 539 F.2d 1300, 1302 (CCPA 1976)).

1

2 The importance of the Examiner providing claim constructions during

3 examination cannot be overemphasized. In order to make a proper comparison

4 between the claimed invention and the prior art, the language of the claims must

5 first be properly construed. See In re Paulsen, 30 F.3d 1475, 1479 (Fed. Cir.

6 1994). See also, Panduit Corp. v. Dennison Mfg. Co., 810 F.2d 1561, 1567-68

7 (Fed. Cir. 1987) (In making a patentability determination, analysis must begin with

8 the question, "what is the invention claimed?" since "[c]laim interpretation, ... will

9 normally control the remainder of the decisional process.") See Gechter v.

10 Davidson, 116 F.3d 1454, 1460 (Fed. Cir. 1997) (requiring explicit claim

11 construction as to any terms in dispute). "Both anticipation under § 102 and

12 obviousness under § 103 are two-step inquiries. The first step in both analyses is a

13 proper construction of the claims. ... The second step in the analyses requires a

14 comparison of the properly construed claim to the prior art." Medichem, S.A. v.

15 Rolabo, S.L., 353 F.3d 928, 933 (Fed. Cir. 2003) (internal citations omitted).

16 Therefore, only after a claim construction has been made can the claims be

17 properly examined. The importance of claim construction has also been

18 recognized by the Patent Office in a presentation entitled "Making Effective Use of

the Appeals Process & Practice Tips"¹, in which it was stated that "Appeals are won or lost on:

- Claim interpretation
- Findings of fact
- Application of the correct law"

Since a claim construction was not previously provided by the Examiner and since the Honorable Board's analysis rests upon an issue of claim construction, which is critical to the ultimate issue of patentability, Appellant respectfully submits that the Honorable Board's newly-presented claim construction represents a new ground of rejection and should be designated as such.

Although Appellant has previously not been able to react to the specific thrust of the rejection, Appellant has presented arguments as to the Examiner's analysis, which was the basis of the Honorable Board's claim construction. In particular, Appellant presented the following arguments on page 10 of the First Reply Brief:

In particular, the Examiner asserted that whether or not a sever is available (or down) corresponds to the claimed "communication character of a ... link." Appellant respectfully disagrees with this assertion. The entire claimed limitation at issue is "a communication characteristic of an inter-broker communication link between the message brokering system and one of said connected message brokering systems." Thus, the Examiner has ignored that the "link" is an "inter-broker communication link" (emphasis added) and that the link is "between the

¹ http://www.uspto.gov/web/offices/pac/dapp/opla/presentation/ca_bar_0607.html.

1 message brokering system and one of said connected message brokering
2 systems." As already argued above, it is improper for the Examiner to ignore a
3 claimed limitation.
4

5 Moreover, the Examiner has ignored the ordinary and customary meaning
6 of the term "link." The Examiner is improperly asserting that the servers of
7 Narasimhan correspond to the claimed link. A network is comprised of nodes,
8 which are connected by links. Whereas Narasimhan includes teachings with
9 regard to a characteristic of the nodes (i.e., the servers) of the network, the
10 claimed invention regards communication characteristics of the communication
11 links, which are different than the nodes (i.e., a message broker system and one of
12 the connected message brokering systems). (emphasis in original)
13

14 The arguments presented in the above-reproduced passages from the Reply
15 Brief raise two important points.
16

17 First, the entire claim limitation at issue is "a communication characteristic
18 of an inter-broker communication link between the message brokering system and
19 one of said connected message brokering systems." As specifically argued above
20 within the Reply Brief, the "link" is an "inter-broker communication link"
21 (emphasis added) and that the link is "between the message brokering system and
22 one of said connected message brokering systems." These limitations, however,
23 were not addressed by the Examiner. Not only were these limitations not
24 addressed by the Examiner, the Honorable Board's analysis on pages 11 and 12 of
25 the Decision is also silent as to identifying where the applied prior art teaches or
26 renders obvious that the link is an inter-broker communication link and that the

1 link is between the message brokering system and a connected message brokering
2 system.

3
4 For Narasimhan to teach the limitations for which the Examiner is relying
5 upon Narasimhan to teach, Narasimhan needs to teach that the disclosed
6 communication link is between two message brokering systems (i.e., an inter-
7 broker communication link). Narasimhan, however, only teaches a single message
8 brokering system, which is the combination of all the elements described in Fig. 1
9 of Narasimhan. Since Narasimhan does not teach multiple message brokering
10 systems, Narasimhan cannot teach the claimed inter-broker communication link is
11 between two message brokering systems.

12
13 Appellant's position, therefore, is that since neither the Examiner nor the
14 Honorable Board identified any teachings within the applied prior art that teach or
15 render obvious the claimed "an inter-broker communication link between the
16 message brokering system and one of said connected message brokering systems,"
17 Appellant has established that the Examiner has committed legal error for properly
18 identifying the scope and content of the applied prior art and the differences
19 between the applied prior art and the claims at issue, and the Honorable Board has

misapprehended and/or overlooked certain arguments presented by Appellant on page 10 of the First Reply Brief.

The second point revolves around the claimed "characteristic of an inter-broker communication link," a discussion of which is found in the last full paragraph on page 10 of the First Reply Brief (and reproduced above) and the Honorable Board's assertion on page 12 of the Decision that:

The claimed "communication characteristic of an inter-broker communication link" is broad enough to encompass the characteristic of whether an inter-broker communication link is effective to communicate with a server. If the server is down, the link is not effective to communicate with that server.

The words of the claim must be given their plain meaning unless Appellant has provided a clear definition in the specification. In re Zletz, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989). The key phrase at issue is the "characteristic of an inter-broker communication link." The definition of characteristic² is "a distinguishing trait, quality, or property." And "to distinguish" means "to perceive a difference in" or "to mark as separate or different" or "to separate into kinds, classes, or categories."

² <http://www.merriam-webster.com/dictionary/characteristic>.

1 Turning to the Honorable Board's claim construction, the Honorable Board
2 asserts that the "characteristic" is "whether an inter-broker communication link is
3 effective to communicate with a server." Additionally, the Honorable Board
4 describes a situation in which "[i]f the server is down, the link is not effective to
5 communicate with that server." The characteristic identified by the Honorable
6 Board and relied upon by the Examiner, however, is not a characteristic of the
7 inter-broker communication link, as claimed. Instead, the characteristic is one of
8 the network, as a whole, or of the server, individually.

9
10 The truth of this assertion can be illustrated by example. Presume that an
11 identical inter-broker communication link is, in a first instance, connected to an
12 operational server and is, in a second instance, connected to a non-functional
13 server. While employing the Honorable Board's claim construction, there must
14 necessarily be a recognition that the inter-broker communication link in the first
15 instance has a different characteristic than the inter-broker communication link in
16 the second instance since the link is not effective to communicate with the server
17 in the second instance whereas the link is effective to communicate with the server
18 in the first instance. However, the inter-broker communication link has not
19 changed between the first instance and the second instance.

1 Referring back to the plain and ordinary meaning of the term "characteristic"
2 and characteristic is a trait, quality, or property that distinguishes one 'thing' from
3 another 'thing," and "to distinguish" means "to perceive a difference in." However,
4 there is no difference between the trait, quality, or property of the inter-broker
5 communication link between the first instance and the second instance. Thus, the
6 inter-broker communication link in the first and second instances must have the
7 same characteristics. Along the same line of reasoning, therefore, the differences
8 between the first instance and the second instance cannot be considered a
9 characteristic of the inter-broker communication link. Likewise, whether or not the
10 server is up or down is not a characteristic of the communication link disclosed by
11 Narasimhan.

12
13 When the Honorable Board asserts that "if the server is down, the link is not
14 effective to communicate with that server," Appellant respectfully, yet vigorously,
15 submits that the Honorable Board's analysis is not accurate. If the server is down,
16 the link is still effective in communication with that server since if that server was
17 replaced with an operation server, the link would still work. By analogy, if a light
18 bulb within a lamp blows, it does not mean that the wiring to the lamp is not
19 effective in lighting the light bulb. The wiring is very likely still good (i.e., the
20 characteristic of the wiring to the lamp is unchanged) and is still capable of

1 lighting a light bulb. The light bulb blowing likely means that the blown light bulb
2 within the lamp needs to be replaced with a new light bulb.

3
4 The claimed limitations at issue are not directed to the characteristic of the
5 network, as a whole, or a node (e.g., a server) within the network. Instead, the
6 claimed limitation is specifically directed to a link (i.e., the connection between
7 nodes within a network). Moreover, as argued above with regard to the first point,
8 the link is not any generic link. Instead, the claimed link has been specifically
9 narrowed to an inter-broker communication link between the message brokering
10 system and a connected message brokering system. Appellant's arguments within
11 the last full paragraph on page 10 of the Reply Brief are specifically directed to
12 these differences between the claimed term of "link" and that of "networks" and/or
13 "nodes." Therefore, Appellant respectfully submit that the Honorable Board has
14 misapprehended and/or overlooked certain arguments presented by Appellant in
15 the last full paragraph on page 10 of the First Reply Brief.

16
17
18 Summary

19 Appellant raised two important points on page 10 of the First Reply Brief
20 that have either been misapprehended and/or overlooked by the Honorable Board.

1 First, the claimed communication link is not a generic communication link but
2 instead, an inter-broker communication link between a message brokering system
3 and a connected message brokering system, and the Examiner's analysis has been
4 completely silent with regard to this specific type of communication link. Second,
5 the characteristic identified by the Examiner and relied upon by the Honorable
6 Board is not a characteristic of a communication link. Instead, the identified
7 characteristic (i.e., whether the server is down or up) is associated with either the
8 node (e.g., the server) or the network, as a whole, which comprises a combination
9 of one or more links and multiple nodes.

10
11 For the reasons set forth in the Appeal Brief and in the First and Second
12 Reply Briefs, Appellant respectfully solicits the Honorable Board to reverse the
13 Examiner's rejections under 35 U.S.C. § 103.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 09-0461, and please credit any excess fees to such deposit account.

Date: May 18, 2009

Respectfully submitted,

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CUSTOMER NUMBER 46320